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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,323	07/15/2004	Kensuke Fujii	04853.0115	7887

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EXAMINER	
KRECK, JOHN J	

ART UNIT	PAPER NUMBER
3673	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/501,323	FUJII ET AL.	
	Examiner	Art Unit	
	John Kreck	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The amendment dated 10/28/05 has been entered.

Claims 1-10 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glaze, et al. (U.S. Patent number 5,593,888) in view of "Gardening Series Basics Choosing a Soil Amendment".

Glaze teaches the method of purifying contaminated soil comprising adding a soil improving material (unspecified "other amendments" column 15, line 40); and mixing the soil by agitation while adding microbes.

Glaze fails to explicitly disclose the nature of the amendments, and thus fails to disclose the water-absorbing properties and capability of maintaining non-swelling property and non-viscosity.

"Gardening Series" (page 3, under "Soil texture") teaches that it is advantageous to add perlite to clay soils to improve their permeability. Applciant's specification teaches that perlite inherently meets the claimed properties.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Glaze process to have included perlite as the "other amendment", in order to improve soil permeability, for example; thus resulting in the claimed properties called for in claim 1.

With regards to claim 2; Glaze apparently discloses microbes not contained by the soil-improving material.

Glaze teaches aeration as called for in claim 3.

"Gardening Series" teaches inorganic material as called for in claim 4.

"Gardening Series" teaches perlite as called for in claim 5.

Regarding independent claim 6:

Glaze teaches the method of purifying contaminated soil comprising adding a soil improving material (unspecified "other amendments" column 15, line 40); and mixing the soil by agitation while adding microbes.

Glaze fails to explicitly disclose the nature of the amendments, and thus fails to disclose the water-absorbing properties and capability of maintaining non-swelling property and non-viscosity.

"Gardening Series" (page 3, under "Soil texture") teaches that it is advantageous to add perlite to clay soils to improve their permeability. Applciant's specification teaches that perlite inherently meets the claimed properties.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Glaze process to have included perlite as the "other

amendment", in order to improve soil permeability, for example; thus resulting in the claimed properties called for in claim 6.

Glaze teaches the microbes and soil-improving material separately added (see column 10, lines 36 and column 29, lines 29-30) as called of in claim 7.

Glaze teaches aeration as called for in claim 8.

"Gardening Series" teaches inorganic material as called for in claim 9.

"Gardening Series" teaches perlite as called for in claim 10.

Response to Arguments

2. Applicant's arguments filed 10/28/05 have been fully considered but they are not persuasive.

Applicant has argued that a prima facie case of obviousness has not bee made because the references allegedly fail to teach or suggest "adding a soil-improving material to purify contaminated soil by microorganisms." It is noted that this phrase is not found in any claim; nonetheless, it is the position of the examiner that each claim limitation is taught or suggested. Glaze clearly teaches a method of purifying including adding an (unspecificed) amendment, mixing, and adding microbes (e.g. column 15, lines 39-41). It is noted that applicant has made the unsupported assertion that "Glaze does not teach the method of purifying contaminated soil using microorganisms"; this is clearly contradicted by the text of Glaze (see, e.g. the title).

The Gardening document is cited for teaching well-known soil amendments (e.g. perlite) which have properties which inherently meet the claimed limitations. Applicant

has cited MPEP 1241.02: "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established." This is not disputed: it is apparent that the disagreement is whether the obviousness rejection is "predicated on what is not known at the time an invention is made". In this case the obviousness of adding perlite to soil is not based on the claimed properties of the soil amendment {although it is not conceded that these properties were unknown}. The obviousness is based on the fact that it was known to add perlite to soil to improve soil permeability: that is, one of ordinary skill in the art would have found it obvious to have modified the Glaze process to have added perlite to the soil. Such modification would meet the claim limitations because the claimed properties are inherent in perlite. See MPEP 2112: "the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable." In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977) and "There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference." Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003)

With regards to applicant's assertion that Examiner has not provided any motivation to combine, applicant's arguments are not persuasive: Glaze clearly teaches mixing with soil, and the cited text (15:39-41) fails to mention an "air-stream" as alleged by applicant. Applicant has further argued that "Glaze in no way suggests that materials be added to soil without the use of an apparatus". It is not clear what applicant intends

by this argument: the claims do not preclude the use of an apparatus, and applicant's invention is understood to use an apparatus.

With regards to applicant's assertion that Examiner has not indicated any reasonably expectation of success; this is implicit in the rejection: if Examiner had evidence of success, then the rejection would have been made under 102. Applicant has not provided any evidence that one of ordinary skill in the art would not have expected success.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is 571-272-7042. The examiner can normally be reached on Mon-Thurs 530am-2pm; Fri: telework.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on 571-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John Kreck
Primary Examiner
Art Unit 3673

20 December 2005